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PATENT APPLICATION

ATTORNEY DOCKET NO. MOMI-025

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hank Risan, et al.

Confirmation No.: 5340

Application No.: 10/772,025

Examiner: Moorthy, Aravind K.

Filing Date: 02/03/2004

Group Art Unit: 2431

Title: Method and System for Preventing Unauthorized Recording of Media Content in an iTunes TM Environment

Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
INDICATED IN NOTICE OF ALLOWANCE
(37 C.F.R. 1.705)

NOTE: 37 C.F.R. 1.704 (e): "Submission of an application for patent term adjustment under 1.705(b) (with or without request under Sec. 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section."

1. This request for reconsideration of the patent term adjustment indicated in the Notice of Allowance mailed on 4/16/2009

☒ The issue fee is being paid as set forth in the papers attached hereto.

2. Applicant submits herewith a "Statement of the Correct Patent Term Adjustment: Basis(es) Under 1.702 For the Adjustment-Part B." (37 C.F.R. 1.705(b)(2)(i) and (ii)).

3. Any patent granted on this application (37 C.F.R. 1.705(b)(2)(iii)):

☐ is not subject to a terminal disclaimer.

☒ is subject to a terminal disclaimer, and the expiration date specified in the terminal disclaimer is not listed in either of the 2 terminal disclaimers.

4. As to circumstances during the prosecution of this application constituting a failure to engage in reasonable efforts to conclude processing or examination of this application as set forth in 1.704 (37 C.F.R. 1.705(b)(2)(iv)):

☐ there were none (37 C.F.R. 1.705(b)(2)(iv)(B)). ☒ there were as follows (37 C.F.R. 1.705(b)(2)(iv)(A)):

- 11/13/2007, Applicant delay of 6 days in filing response; and
- 5/6/2008, Applicant delay of 5 days in filing RCE.

5. Also attached hereto is a "Request for Reinstatement For ☐ All and/or ☐ Part of the Period Adjustment Reduced Pursuant to 1.704(b)-Part C." (37 C.F.R. 1.705(c)).

6. The fee set forth in 1.18(e) (\$200.00), required by 37 C.F.R. 1.705(b)(1), is paid as follows:

Please charge Deposit Account 50-4157 \$ 200.00 . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 50-4157 pursuant to 37 CFR 1.25.

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Commissioner for Patents, Alexandria, VA 22313-1450
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OR

☒ I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (571)273-8300 or via electronic submission.

Date of facsimile/transmission: 06/08/2009

Typed Name: Brenda Dinapoli

Signature: /Brenda Dinapoli/

Respectfully submitted,

Risan, et al.

By /John P. Wagner, Jr./

JOHN P. WAGNER, JR.

Attorney/Agent for Applicant(s)

Reg No. : 35,398

Date : 06/08/2009

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STATEMENT OF THE CORRECT PATENT TERM ADJUSTMENT:
BASIS(ES) UNDER 1.702 FOR THE ADJUSTMENT
(37 C.F.R. 1.705(b)(2)(i) and (ii))

1. This statement is being submitted in support of the "Request for Reconsideration of Patent Term Adjustment Indicated in Notice of Allowance" to which this statement is attached.

37 C.F.R. 1.705(b)(2)(i)

2. The patent term adjustment shown on the Notice of Allowance is: 845 days

It is respectfully suggested that the correct patent term adjustment under 1.702 is: 1118 days

37 C.F.R. 1.705(b)(2)(ii)

NOTE: Under 1.705(b)(2)(ii) applicant must set forth: "The relevant dates as specified in 1.703(a) through(e) for which an adjustment is sought and the adjustment as specified in 1.703(f) to which the patent is entitled."

3. The basis(es) on which the applicant seeks adjustment are as follows:
The adjustment is sought for the following date: between 8/07/2007 & 5/06/2008
Adjustment to be made for this date: 273

Basis: First Action received 856 days after the 14-mo. date. 3-year rule to allowance violated by 273 days (8/07/2007 - 5/06/2008) that did not overlap the 14-mo. violation. App. delays of 6 & 5 days reduce this, however app. delay has been accounted for in PTA of 845 days. Per Wyeth v. Dudas (580 F. Supp. 2d 138; 88 U.S.P.Q.2D (BNA) 1538, Sept. 30, 2008), USPTO's view that any administrative delay under 35 U.S.C.S. § 154(b)(1)(A) overlapped any three-year maximum pendency delay under § 154(b)(1)(B) could not be squared with language of § 154(b)(1)(B), as "B delay" began when PTO had failed to issue patent within three years, not before. Thus, total PTA should = 845d + 273d = 1118 days.

☐ Plus additional page(s)

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Date of facsimile/transmission: 06/08/2009

Typed Name: Brenda Dinapoli

Signature: /Brenda Dinapoli/

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